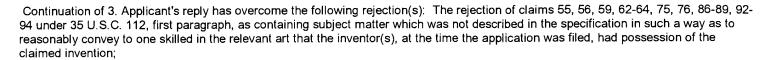UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/246,129 | 02/08/1999 | GUO-LIANG YU | PF141P4 | 5810 |

22195        7590        07/22/2003

HUMAN GENOME SCIENCES INC
9410 KEY WEST AVENUE
ROCKVILLE, MD 20850

| EXAMINER |
|---|
| ROMEO, DAVID S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1647 | |

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): <u>See Continuation Sheet</u>.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet</u>.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: <u>55,56,59,62-66,69 and 72-74</u>.

    Claim(s) objected to: <u>43-47</u>.

    Claim(s) rejected: <u>42,48 and 52-54</u>.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). <u>32</u>.

10. ☐ Other: _____

David S Romeo
Primary Examiner
Art Unit: 1647

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 55, 56, 59, 62-64, 75, 76, 86-89, 92-94 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention;

the rejection of claims 89, 92-94 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention; and,

the rejection of claims 55, 56, 59, 62-64 under 35 U.S.C. ' 112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 42, 48, 52, 53, 54 are indefinite because they recite the term "a polypeptide having the amino acid sequence expressed by a recombinant cell". Because the instant specification does not identify that material element or combination of elements which is unique to, and, therefore, definitive of "a polypeptide having the amino acid sequence expressed by a recombinant cell" an artisan cannot determine what additional or material limitations are placed upon a claim by the presence of this element. The metes and bounds are not clearly set forth. Applicant argues that the scope of the subject claims is clear. Applicant's arguments have been fully considered but they are not persuasive. It is unclear which polypeptide is being expressed by the recombinant cell. It is unclear if the polypeptide has the amino acid sequence expressed by the cDNA or if the polypeptide has some unspecified amino acid sequence "expressed by a recombinant cell.".